



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard Rubin)
Serial No.: 09/664,885) Ex: PASCUA
Filed: 19 September 2000) Art Unit: 3727
For: INSULATED FOOD CONTAINER)

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TRANSMITTAL OF RESPONSE TO EXAMINER'S ANSWER

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

Enclosed is a Responsive Brief for Appellants and two
copies of same.

Respectfully submitted,

Robert A. Parsons
Attorney for Applicant
Registration No. 32,713

13 January 2004

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Date: 29 December 2003

RUBIN, RICHARD

Art Unit: 3727

Serial No.: 09/664,885

Filed: 19 September 2000

Examiner: Pascua, Jes F.

For: INSULATED FOOD CONTAINER

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APPELLANT'S RESPONSE TO EXAMINER'S ANSWER

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SIR:

Please consider the contents of the following Response to the Primary Examiner's Answer, mailed 14 November 2003, in the subject appeal.

Noted.
02/02/04

In the Examiner's Answer, the Examiner states that appellant's Arguments regarding the 112 rejection are unpersuasive because the specification fails to set forth the structure encompassed by the phrases "constructed to define", "formed to provide", "formed to produce" and "constructed to inhibit". Appellant can only reiterate the obvious. Each of these phrases, if the complete phrase is considered, as it must be according to Patent Law" (*In re Sneed*, 218 USPQ 385 (Fed. Cir. 1983)), includes structure, which structure is also described in the specification.

For example, the phrase "constructed to define" must be interpreted to include the noun phrase: "an insulated and substantially water impermeable food warming chamber". In United States Patent Law, the English language is so important it must be used correctly and cannot for any reason be simply sloughed off as opinion. The English language has very specific rules that clearly and definitely define the use and proper joining of words. While the Examiner has a duty to interpret the claims in the broadest possible way, that interpretation must be reasonable and it cannot do an injustice to the English language. Thus, in the example used above, the Examiner must consider the complete phrase "constructed to define an insulated and substantially water impermeable food warming chamber". It is not within the

Examiner's purview to take a convenient portion of a phrase for the purpose of rejecting a claim. He must interpret the claim in accordance with the English language, giving the words of the claim their plain meaning, and as it would be interpreted by those of ordinary skill in the art. *In re Sneed*, 218 USPQ 385 (Fed. Cir. 1983).

Here it should be noted when the complete phrase is considered in each of the instances pointed out by the Examiner, structure is encompassed that is completely described by the specification. In the above example "constructed to define an insulated and substantially water impermeable food warming chamber", the specification completely describes the structure. Thus, the Examiner's reason for holding the claims indefinite under 35 U.S.C. 112 is not substantiated. Also, it will be noted that none of the cited references, alone or in any proper combination, describe the structure when the complete phrase is considered.

Next, the Examiner cites *In re Casey* to support his argument that Attaway's structure is capable of performing the intended use of appellant's claimed structure. Appellant respectfully disagrees. First, the prior art must be capable of performing the intended use of the entire claimed structure and not just a portion of the claim. All of the claims

include language that entails allowing some moisture to escape from the enclosure. In both the original rejection and the Final Rejection Examiner Garbe stated

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Attaway's nylon layers waterproof, as taught by either Stewart or Goryl, because waterproof material would have prevented the contents of Attaway's container from getting wet and rusting.

Thus, Examiner Garbe recognized and admitted that by simply making Attaway's nylon layers waterproof, Attaway's bag would keep out (or keep in) moisture vapor. This combination of references (Attaway, Stewart, Goryl) was deemed necessary by Examiner Garbe to cover the limitation in the claims "a layer formed of a film of plastic material to provide water impermeability". It is clear that the Patent Office's contemplated combination of the teachings of Attaway, Stewart, and Goryl are not capable of performing the intended use of appellant's claimed structure.

In fact the protection device of Attaway is formed to grip the protected object and there is no teaching or suggestion anywhere in Attaway that it would allow moisture to escape. That is, once pulled into a protective orientation, there is no teaching or suggestion that the upper and lower portions might separate enough to allow moisture to escape from within. In the absence of a clear teaching the next best

thing is the opinion of one of ordinary skill in the art, i.e. Examiner Garbe, who clearly believes the upper and lower portions would stay sealed together sufficiently to prevent moisture from entering and, as suggested by the Examiner, if moisture cannot enter it cannot exit. Thus, the prior art structure contemplated by the Patent Office is not capable of performing the intended use of the claimed structure.

The Examiner goes on to state that Attaway, Stewart, and Goryl are analogous art because they are reasonably pertinent to "the problem of protecting articles contained within the chambers." However, the Examiner fails to realize that "protecting articles" is not the problem solved by appellant. The problem solved by appellant is "keeping food warm and moist", as stated in the preamble that the Examiner rejected as unnecessary. While it is true that Attaway, Stewart, and Goryl are reasonably pertinent to "the problem of protecting articles contained within the chambers" they are completely irrelevant to the problem of "keeping food warm and moist".

As quoted by the Examiner, *In re Oetiker* clearly delineates analogous, or conversely, nonanalogous art. To be analogous, the art must either be in the field of applicant's endeavor or it must be reasonably pertinent to the particular problem with which the applicant was concerned. Here it might

be instructive to note that the word "protect" in any variation (e.g. protecting articles) was never used in appellant's specification or claims. Thus, there is no justification for the assumption or allegation that appellant's field of endeavor or problem solved was "protecting articles". In fact, the only mention of the term "protecting articles" is in the title of Attaway's patent. Thus, by the Examiner's own admission, Attaway is in a different field of endeavor and is nonanalogous art.

Next the Examiner "disagrees with appellant's remark that 'a partial vapor lock' is specific structure." The Examiner goes on to state "Appellant's claim specifically sets forth the functional language 'to provide a partial vapor lock'." The Examiner is wrong. Using the plain meaning of the words of the claim and proper English language (the term "plain meaning" means that the words must be read as they would be interpreted by those of ordinary skill in the art) claim 8 specifically sets forth "constructed to provide a partial vapor lock in the food warming chamber". Further, this language modifies "the partial enclosure caused by the passive, non-sealing lips and the food warming chamber". Thus, "the partial enclosure caused by the passive, non-sealing lips and the food warming chamber" is "constructed to

provide a partial vapor lock in the food warming chamber", which Attaway does not disclose.

The Examiner does admit that "the passive, non-sealing engagement between the lips and the ... chamber" is specific structure. He then alleges that this structure is met by Attaway. However, as discussed above and previously, Examiner Garbe stated that Attaway's structure is sealed against moisture when closed. To overcome this statement appellant believes that more than a simple allegation is required.

The Examiner goes on to discuss each of the four elements listed by appellant as components of claim 1. In each instance the Examiner's argument is that appellant's interpretation of words in the claim as structure is only appellant's "opinion". According to appellant's Brief, element (2) includes the structure: "the pouch being constructed to define an insulated and substantially water impermeable food warming chamber". The Examiner argues that appellant's belief that the modifier "food warming" imparts structure to the noun "chamber" is opinion.

First, it must be noted that appellant did not select two words from the phrase and say they imparted structure. Appellant stated that the entire phrase is structure and must

be considered in its entirety. Thus, the claim does not simply specify a chamber, it specifies "an insulated and substantially water impermeable food warming chamber". When reading the claim, one cannot pick and choose at random the words he likes and doesn't like. "All words in a claim must be considered in judging patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494. 496 (CCPA 1970). Interpreting the claim has nothing to do with appellant's opinion, it has to do with all of the words clearly stated in the claim. Appellant simply contends that all of the words modifying "chamber", including "insulated", "water impermeable", and "food warming" must be considered.

In his discussion of appellant's element 4, the Examiner again states that "to inhibit a build-up of moisture vapor" and "to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist" are functional recitations and it is only an opinion of appellant that they impart structure to the claim. In the first instance the complete phrase is "constructed to inhibit a build-up of moisture vapor". Thus, the construction of the "the partial enclosure" is defined by the language "constructed to inhibit a build-up of moisture vapor". As explained above and previously in the Brief, the entire phrase

must be taken as a whole and cannot be picked apart a word or two at a time.

In the middle paragraph on page 6 of the Examiner's Answer the Examiner states the appellant's supposition that the teachings of Attaway, Stewart, and Goryl would not suggest a warming chamber with lips that allow some moisture to escape but retain some moisture from warm food is unfounded. Appellant respectfully disagrees. All of Attaway, Stewart, and Goryl are nonanalogous art that would never suggest a warming chamber of any type to one skilled in the food art. Further, nothing in any of these references suggests a warming chamber with lips that allow some moisture to escape but retain some moisture from warm food. Examiner Garbe determined that Attaway's protective enclosure would keep out moisture when made waterproof, as taught by either Stewart or Goryl. Therefore, appellant believes that in the absence of some specific teaching in Attaway, Stewart, or Goryl or some other proof, Examiner Pascua cannot simply ignore Examiner Garbe's determination. Thus, appellant's supposition is founded on specific statements and determinations by one of ordinary skill in the art.

In view of the above arguments and those set forth in appellant's brief it is clear that appellant's claims

particularly point out and distinctly claim the subject matter appellant regards as his invention. Further, the claims are definite and clearly set forth the invention which, no proper combination of the applied references, renders obvious. Thus, appellant believes that claims 1-20 are now in condition for allowance.

Accordingly, it is respectfully asserted that appellant's claims 1-20 are clearly allowable and the case is now in condition for allowance. Appellant therefore prays for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

Richard Rubin

A handwritten signature in black ink, appearing to read "Robert A. Parsons", written in a cursive style.

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Dear Sir:

I hereby certify that the attached Transmittal Letter; Responsive Brief for Appellant and two (2) copies of same; and a postcard are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, Mail Stop Appeal Brief-Patents, on 13 January 2004.

Hebe Edwards
Signature

13 January 2004

13 January 2004
Date

Respectfully submitted,

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